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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,265	08/25/2001	Nelson Bolton	626-118	2599

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

4

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ASH

Office Action Summary

Application No.

09/939,265

Applicant(s)

BOLTON ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT***Election/Restrictions***

1. Newly submitted claims 14-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group	Species	Claims
Laminating film	A. Non-scored/Grooved film	A. 14-19
	B. Scored/Grooved film (originally presented species)	B. 20 and 21

Note: Since claims 14 specifically recites "consisting of," which is closed claim language, and does not recite that the laminate consists of grooves/scoring, the claim is constructed as sheet without grooves/scoring.

In view of the construction of claim 14 there are no generic claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-19 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

NEW REJECTIONS

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Note: The term assembly is taken to be a product of manufacture since there are no limitations directed to machines and or deceives to assemble a laminate. It is also noted that claims directed to machinery for assembling a laminate would be subject to restriction by original presentation.

Claim Rejections - 35 USC § 103

4. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clock et al. (3,762,988) in view of Hopfe (5,425,977).

Clock discloses a safety glass laminate comprising a first glass layer, an interlayer, and second glass layer (figure 3). The interlayer comprises between about 60 and about 99.5 weight percent of an polymerized ethylene (polyethylene) and between about 0.5 and about 25 weight percent methacrylic or acrylic acid (alpha olefin carboxylic acid) neutralized 50% (examples 26 through 29) with an alkali metal cation such as sodium. Salt forming cations which may be used to neutralize the carboxylic acid groups of the copolymer include polyamines, such as diamines. See column 5, lines 20-65. In view of Applicant's specification, page 4, line 14, limitation of "up to 5% by weight of a diamine" reads on 0 to 5% by weight of a diamine. Therefore, since Clock does not require a diamine it reads on 0% diamine.

The interlayer has a thickness between 4-200 mils and the glass layers have a thickness of at least about 30-300 mils (0.8-7.5 mm) (col. 8, lines 20-50).

Clock fails to disclose the interlayer comprising indentions/grooves/scores.

Hopfe discloses a laminated safety glass assembly comprising a first layer of glass, an interlayer, and a second layer of glass. The interlayer comprises a multiplicity of microscopic peaks and valleys (indentions/grooves/scores) on its the surfaces (col. 1, line 57 to col. 2, line 14

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and figure 1). The interlayer is a thermoplastic interlayer, which may be a copolymer an olefin and an alpha olefin carboxylic acid with a thickness of about 0.25 to 1.5 mm (10-60 mils) (col. 3, lines 16-35).

The surface roughness of the interlayer increases the quality of the pre laminate by providing a remarkably high degree of light transmission there through (col.1, lines 44-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the multiplicity of microscopic peaks and valleys as taught by Hopfe to the interlayer of Clock because to the improved degree of light transmission gained by the peaks and valleys of Hopfe.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946,

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966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations such as “extruded” is a method of production and therefore does not determine the patentability of the product itself.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments filed in paper #3 regarding the rejection over Clock in view of Hopfe have been carefully considered but are deemed unpersuasive.

Applicant argues that Clock teach away from the presently claimed invention and provides a large catalog of ingredients which includes ranges outside of the invention so that one skilled in the art could not arrive at the present invention without undue experimentation. The fact that the examples only use 10% by weight methacrylic acid containing ionomers as controls does not detract from the fact that Clock specifically teaches 0.5 and about 25 weight percent methacrylic or acrylic acid (alpha olefin carboxylic acid). Furthermore, claim 20 is not merely limited to methacrylic acid, but all alpha olefin carboxylic acid. The Examiner disagrees with Applicant's assertion that Clock provides a large catalog of ingredients which would cause undue experimentation. Clock provides only 10 different carboxylic acids in his list the majority of which are alpha olefin carboxylic acid. Since a majority of the acids read on Applicant's claimed limitation of alpha olefin carboxylic acid it would not constitute undue experimentation.

Applicant further argues that Clock is silent with regard to the assembly of claims 20 and 21. The examiner disagrees with this statement since all the limitations of claim 20 and 21 have been met by the combination of Clock and Hopfe, see above rejection.

Applicant's arguments regarding Hopfe are moot since Hopfe was merely realized upon for grooves/scores.

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6. Applicant's arguments filed in paper #3 regarding the Murase, Smith and Bolton references have been carefully considered but are moot since rejections using these references were not applied to the new claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the

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organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/6/03

A handwritten signature, possibly reading 'AE', written in black ink.A handwritten signature in black ink, which appears to be 'William P. Watkins III'.

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**